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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,735	09/01/2000	Andrew F. Suhy JR.	65678-0032	5810

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EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/653,735	SUHY, ANDREW F.	
	Examiner	Art Unit	
	Calvin L Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-8 and 12-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 1-8 and 12-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Status of Claims

1. Claims 1-8 and 12-24 have been examined.

Response to Amendments

2. Regarding surcharges, the Applicant has not specifically stated why the noticed fact is not considered to be common knowledge or well-known in the art. On the contrary, by Applicant's own admission, surcharges are well known (paper no. 8, page 11) and the mere appliance of a surcharge will not distinguish the clear teachings of the prior art from the Applicant's claimed system and method. Webster's Ninth Collegiate Dictionary defines a surcharge as an "overcharge", "extra fee", "an additional tax, cost or impost", hence to apply a surcharge is at least an obvious method of increasing revenues on the part of the party applying the surcharge. Similarly, Webster's Ninth Collegiate Dictionary defines a "rate" as "a quantity, amount, or degree of something measured per unit of something else" or "an amount of payment or charge based on another amount". Therefore, it would have been obvious to calculate a rate based on any quantity, amount, or degree of something within the scope of knowledge and understanding of one of ordinary skill in the appropriate art, such as owners of equipment who also maintain the equipment that they lease to others.

Albertshofer teach lease pricing derived from equipment usage (column 6, lines 23-27), hence, it necessarily teaches a variable "lease rate", as the lease price is a function of a variable (i.e. equipment usage). Also, claims 2-4, 15-17, 19, 21 and 22 ("if said operating characteristic...", "when said utilization...", "if measurement...") recite conditional limitations. Therefore, in order to reject said limitations, the Examiner need only consider the alternative.

The claims have been adjusted to reflect amendments to the claims. No new art has been applied.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-7 and 12-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koether, U.S. Patent No. 5,875,430 in view of Albertshofer, U.S. Patent No. 6,230,081.

As per claims 1-7 and 12-24, Koether teaches a system for gathering and analyzing data regarding an asset comprising:

- a local controller, analysis controller, electronic communications network, and a sub-system that analyzes at least one operating characteristic of the asset (figures 1-3 and 7A-8)
- monitoring a plurality of characteristics over a fixed period of time (figure 7A; column/line 8/48-9/3; column 9, lines 28-34)
- receiving operating characteristics adjusted by maintenance information to provide an overall asset utilization (column/line 8/48-9/44)
- asset user, asset owner, and asset supplier or maintenance organization (figure 8; column 10, lines 30-45)
- assets are limited in motion to a pre-determined geographic region (column 4, lines 22-36)

Regarding surcharges (claims 2-4), the Examiner takes Official Notice that surcharges and the appliance of surcharges are old and well-known to those of ordinary skill in the art. Koether also teaches transmitting data (figures 1-3). Therefore, it would have been obvious to transfer data by any means (e.g. real-time, "almost" real time, batch, sequentially, push, pull) in order to implement corporate policy and produce a desired result. However, Koether doesn't explicitly recite determining a lease rate. Albertshofer teaches an asset usage monitoring system that monitors asset performance (e.g. plurality of

characteristics over a fixed period of time, maintenance information) to determine a leasing rate (column 1, lines 55-61; column 2, lines 36-44; column 3, lines 31-39; column 4, lines 10-26; column 6, lines 23-27 and 40-50) and assets that are limited in motion to a pre-determined geographic region (figure 1; column 4, lines 30-37). Further, Webster's Ninth Collegiate Dictionary defines a "rate" as "a quantity, amount, or degree of something measured per unit of something else" or "an amount of payment or charge based on another amount". Therefore, it would have been obvious to calculate a rate based on any quantity, amount, or degree of something within the scope of knowledge and understanding of one of ordinary skill in the appropriate art, such as owners of equipment who also maintain the equipment that they lease to others. Therefore, it would have been obvious to one of ordinary skill to combine the systems of Koether and Albertshofer in order to accurately determine fees for the rental or leasing of capital equipment.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koether, U.S. Patent No. 5,875,430 and Albertshofer, U.S. Patent No. 6,230,081 as applied to claim 1 above, and further in view of Nguyen et al., U.S. Patent No. 6,003,808.

As per claim 8, Koether (figures 1-3 and 7A-8) teaches a system for monitoring the performance of an asset and Albertshofer (column 4, lines 10-26;

column 6, lines 23-27 and 40-50) teaches deriving lease rate information based asset usage. However, neither reference explicitly recites analyzing maintenance information to evaluate a relationship based on maintenance performance. Nguyen et al. teach a maintenance and warranty control system that includes analyzing maintenance information to evaluate a relationship based on maintenance performance (column/line 4/32-5/15). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Koether, Albertshofer and Nguyen et al. in ordinary to validate warranty claims and/or allow an asset owner to determine whether to recall, or re-engineer a product based on, for example, the number of warranty claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

August 5, 2003